

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application and for the personal interview conducted on June 2, 2004, with the Examiner and his supervisor. The application has been carefully reviewed in light of the Office action, and it is respectfully submitted that the application as amended is patentable over the art of record. Reconsideration of the application as amended is respectfully requested.

Claims 1-8 remain in this application.

Claims 1-2, and 7-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rahrer et al. (U.S. Patent No. 6,005,927). For the following reasons, the Examiner's rejection is respectfully traversed.

Claim 1, as amended, recites "a plurality of telephone directories including a plurality of user selectable directories for storing user selected phone numbers" wherein a "telephone number stored in the temporary storage memory is registered in at least one telephone directory memory associated with one of said user selectable directories selected from the plurality of telephone directories after making a call". The references do not teach claim

As discussed at the personal interview, Rahrer does not teach a plurality of user selectable directories for storing user selected phone numbers. Instead, Rahrer merely teaches a single user selectable directory called the "personal directory". The only other directory discussed by Rahrer is the "dialed directory" which is merely a list of recently dialed phone numbers, and does not store user selected phone numbers, but instead automatically stores called numbers. Hence, claims 1 and 2 are patentable over the reference.

Regarding the rejection of claims 7-8, these claims have been amended as suggested by the Examiner's supervisor to recite that the telephone directory memory used for registering the telephone number stored in the temporary storage memory after a call is selected, manually or

automatically, from one of the "plurality of the telephone directory memories associated with the user selectable directories". Because Rahrer does not disclose or teach multiple user selectable directories (as discussed above), the claims are patentable over the reference.

Claims 3-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rahrer *et al.* in view of Borland (U.S. Patent No. 6,320,943). For the following reasons, the Examiner's rejection is respectfully traversed.

First, claims 3-6 depend, directly or indirectly, on one or more of the claims discussed above, and because Borland does not overcome the shortcomings of Rahrer, they are patentable over the combination for at least the same reasons as their parent claim(s).

Further, claims 4 & 5 recite that a directory or memory buffer telephone number, respectively, is "*automatically* erased after passage of a *predetermined time*." The Examiner cited Borland, col. 7, lines 9-11, as teaching this element of the claims.

However, as discussed at the personal interview, a close reading of the cited material does not support the Examiner's assertion. Instead, Borland teaches that, when the memory gets full, the least frequently used numbers that have not been used for a given period of time are deleted. Thus, the trigger to deletion is that the memory is full. Only then are the numbers examined for last use, and those that have not been used for some period of time are erased. If the memory gets full, there is no deletion.

In contrast, claims 4 and 5 are interpreted, from the literal claim language, that the number is erased after the passage of a certain time period, regardless of whether the memory is full or not. This means that the passage of time alone triggers the deletion. Thus, for example, one might say that the number is erased after a predetermined time of 24 hours. Then, after the passage of that time, the number is gone, whether or not the memory is full. Borland requires that the memory be full, first, before any erasure will occur. And then, the

least recently used numbers are erased, while the newer ones are maintained. Thus, the two features result in quite different results.

Consequently, as discussed at the personal interview, Borland does not teach the cited elements of claims 3 and 4, and thus they are patentable over the references.

With regard to claims 5 and 6, the Examiner's supervisor suggested that the claims be amended to recited "interface means for connection with an external memory device external to said terminal device". As was discussed at the personal interview, the Borland device merely teaches an internal memory that may comprise one or more separate memories (see col. 4, lines 13-15, and Fig. 1). There is no suggestion or teaching that an memory external to the device be used. Thus, claims 5 and 6 overcome the Borland reference and thus are patentable over the combination.

Finally, as discussed in prior responses, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Rahrer and Borland to arrive at the claimed invention. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/595,204

Amdt. Dated June 21, 2004

Reply to Office action of January 20, 2004 and Interview of June 3, 2004

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. 32739.

Respectfully submitted,

PEARNE & GORDON LLP

By:


Robert F. Bodi, Reg. No. 48540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: June 21, 2004